

## REMARKS

Reconsideration of this application as amended is respectfully requested.

In the Office Action, claims 1-5, 7-17, 19-29, 31-41 and 43-52 were pending and rejected. In this response, no claim has been canceled or amended. No new matter has been added.

Claims 1-4, 7, 13-16, 19, 25-28, 31 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Schena et al., U.S. Patent No. 6,448,979 (“Schena”). Applicant hereby reserves the rights to swear behind Schena in the subsequent prosecution of the present application. It is respectfully submitted that the currently pending claims include limitations that are not disclosed by Schena. Specifically, independent claim 1 recites as follows:

1. A method comprising:  
creating a multimedia annotation for a paper document, the multimedia annotation representing at least one of an audio sound and a video clip;  
and  
creating a first multimedia document by combining the paper document and the multimedia annotation, such that the multimedia annotation can be extracted and decoded subsequently from the first multimedia document and played via a multimedia player, wherein the first multimedia document is generated as a part of reproducing the paper document via a document reproduction system.

(Emphasis added)

Independent claim 1 includes creating a multimedia annotation to be used with a paper document, where the multimedia annotation represents at least one of an audio clip and a video clip. A multimedia document is created by combining the paper document and the multimedia annotation while reproducing the paper document via a document reproduction system (e.g., a copy machine). The multimedia annotation can then be extracted from the

multimedia document subsequently and played via a multimedia player. It is respectfully submitted that the above limitations are absent from Schena.

Rather, instead of creating a multimedia document by combining a paper document with a multimedia annotation, Schena discusses extracting a machine readable code from an existing printed medium, where the machine readable code contains a URL to access a remote location to retrieve provider information (see, Abstract of Schena). There is no mention or suggestion within Schena of creating a multimedia document by combining a paper document with a multimedia annotation, particularly, as a part of reproducing the paper document via a document reproduction system, such as, for example, a copy machine.

In addition, Schena fails to disclose or suggest that the machine-readable code of the printed medium represents at least one of an audio clip and a video clip. Rather, the machine-readable code of Schena contains a URL link to a remote location from which the provider information can be downloaded (see, col. 2, lines 8-25 of Schena).

In order to anticipate a claim, each and every limitations of the claim have to be disclosed by the reference. It is respectfully submitted that Schena fails to disclose each and every limitations set forth above. Therefore, for the reasons discussed above, it is respectfully submitted that independent claim 1 is not anticipated by Schena.

Similarly, independent claims 13, 25, and 37 include limitations similar to those recited in claim 1. Thus, for the reasons similar to those discussed above, independent claims 13, 25, and 37 are not anticipated by Schena.

Given that the rest of the claims depend from one of the above independent claims, at least for the reasons similar to those discussed above, it is respectfully submitted that the rest of the claims are not anticipated by Schena.

Claims 5, 17 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of Gormish et al., U.S. Patent No. 5,337,362 (“Gormish”).

It is respectfully submitted that Gormish also fails to disclose or suggest the limitations set forth above. Claims 5, 17, and 29 depend from one of the above independent claims. For the reasons similar to those discussed above, it is respectfully submitted that claims 5, 17, and 29 are patentable over Schena in view of Gormish.

Claims 8-10, 20-22, 32-34, 37-41 and 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of Robinson et al., “The Origami Project: Paper Interfaces to the World-Wide Web,” (“Robinson”).

It is respectfully submitted that none of cited references, individually or in combination, discloses or suggests the limitations set forth above. Most of these claims depend from one of the above independent claims. Thus, for the reasons similar to those discussed above, it is respectfully submitted that 8-10, 20-22, 32-34, 37-41 and 45-52 are patentable over the cited references.

In addition, with respect to claims 8, 20, and 32, these claims include generating an image of a paper document (e.g., electronic copy of the paper document) unconsciously without user intervention via a document reproduction system (e.g., a copy machine). A multimedia document is created by combining the image of the paper document with a multimedia annotation that is captured via an input device of the document reproduction system while reproducing the paper document. It is respectfully submitted that these limitations are absent from the cited references.

Although Robinson discloses an overhead camera on a user’s desk to create a digital desk, which projects an image of a paper document on the desk. However, Robinson fails to disclose combining an image of the paper document with a multimedia annotation captured

from a user, particularly, via an input device of the document reproduction system (e.g., copy machine).

Therefore, for the reasons discussed above, claims 8, 20, and 32 are independently patentable over the cited references.

With respect to claims 45-52, these claims are related to specific ways to generate the multimedia annotation according to certain embodiments, such as, for example, via a microphone attached to the document reproduction system as recited in claims 45-46, via a video camera attached to the document reproduction system as recited in claims 47-48, and/or based on a content-based search as recited in claims 49-52, etc. It is respectfully submitted that these limitations are completely absent from Schena and Robinson.

In the Office Action, the Examiner stated:

“Schena does not specifically indicate at what point in time or with what event the multimedia annotation is created. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Schena to have automatically captured ... annotation for the paper document when the paper document was being reproduced so that the multimedia is relevant to both the user and the paper document.”

(12/6/2004 Office Action, pp. 8-10)

Applicant respectfully disagrees. There is no mention or suggestion within the cited references to support the Examiner’s interpretation. It appears that the Examiner’s interpretation is based on Applicant’s own disclosure.

Further, there is no disclosure or suggestion within the cited references to combine with each other. It would be impermissible hindsight based on Applicant’s own disclosure for such a combination. As described above, Schena discusses extracting machine-readable code, which contains a link to a remote location, out of an existing printed medium and accessing the linked remote location to retrieve additional information. Schena is does not relay how

the existing printed medium is generated. Adding the present invention as claimed to Schena would only destroy the purposes of Schena. Even if they were combined, such a combination still lacks the limitations set forth above. Therefore, for the reasons discussed above, it is respectfully submitted that claims 8-10, 20-22, 32-34, 37-41 and 45-52 are patentable over Schena in view of Robinson.

Claims 11, 23, 35 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of Robinson and U.S. Patent No. 6,208,436 of Cunningham (“Cunningham”). Claims 12, 24 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of Robinson and Cunningham, and further in view of Halliday et al., U.S. Patent No. 5,880,740 (“Halliday”).

Claims 11-12, 23-24, 35-36, and 43 depend from one of the above independent claims. It is respectfully submitted that neither Cunningham nor Halliday discloses or suggests the limitations set forth above. Therefore, for the reasons similar to those discussed above, it is respectfully submitted that claims 11-12, 23-24, 35-36, and 43 are patentable over the cited references.

In addition, there is no suggestion within the cited references to combine with each other. In order to combine two or more references, there must be some suggestions or motivations within the cited references to combine with each other. The Examiner fails to provide any suggestion or motivation within the cited references to combine these references (e.g., 3 to 4 different references) to render a claim obvious.

In order to render a claim obvious, each and every limitation of the claims must be disclosed or suggested by the cited references. It is respectfully submitted that the cited references (e.g., 3-4 different references), individually or in combination, disclose or suggest

the limitations set forth above. Therefore, 11-12, 23-24, 35-36, and 43 are patentable over the cited references. Withdrawal of the rejections is respectfully requested.

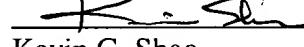
In view of the foregoing, Applicants respectfully submit the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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